

REQUEST FOR RECONSIDERATION UNDER 37 C.F.R. § 1.111
U.S. Appln No. 09/511,898
ATTORNEY DOCKET NO. Q58044

As a threshold matter, the Examiner cannot point to any teaching in Yamagishi '413 that discloses the product of Shore D hardness of cover outer layer and cover inner layer. Clearly, the Examiner is reading more into Yamagishi '413 than it fairly teaches. The prior art is relied upon for all that it discloses and not for that which it potentially could state. Unambiguously, Yamagishi '413 does not disclose or teach the fundamental concepts defined by the Applicants. As noted in *In re Vaeck*, 947 F.2d, 488 (Fed. Cir. 1991), the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not in the applicant's disclosure.

Aside from the fact that Yamagishi '413 does not disclose any dimples, more importantly are two other defects with respect to Yamagishi '413. First, there is no criticality and thus no disclosure of the proportion of dimples V_R (%) and the value V_0 of the dimples. Yamagishi '413 is simply silent on this point. Second, and more important, Yamagishi '413 does not disclose the product of a Shore D hardness of a cover inner layer and the Shore D hardness of a cover outer layer. This is a critical defect. Thus, Yamagishi '413 does not in any way disclose the relationship between the product of Shore D hardness of the two layers and as a result, the value of V_R of the dimples would not be expected or obvious given that fundamental precursor defect.

Consequently, even if the Shore D products in the range of 1,500 to 4,000 would be expected from the Shore D hardness of the two layers disclosed, the particular range of values of V_R corresponding to the product is simply an unobvious extrapolation of that information. Thus, the two-fold defect in Yamagishi '413 is that it provides no data whatsoever concerning the product of Shore D hardness of the cover outer layer and the cover inner layer, even if that is defined as the

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multi-piece golf ball defined by the Examiner as pertinent, and there is no relationship between any such product and the value of V_R .

Fundamentally, the claimed invention is predicated on the recognition that two entirely dissimilar properties of a golf ball, when limited to specific ranges, increase golf ball performance. There is nothing in the combination of Yamagishi '413 and Yamagishi '563 that discloses the fundamental recognition of a combination of a particular range of V_R in a particular range of the product of Shore D hardness of the cover inner and cover outer layers. The only way in which the combination of Yamagishi '413 and Yamagishi '563 can be recreated is by forcibly dissecting it into components to find the individual pieces. However, even if the individual pieces or components are found, obviousness does not still exist absence of motivation or suggestion of combination. As noted in *In re Vaeck*, 947 F.2d, 488 (Fed. Cir. 1991), the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not in the applicant's disclosure. The fact that the elements in their disparate form exist does not lead to the conclusion of *prima facie* obviousness unless the artisan would have some suggestion or motivation for combination. Clearly that is not the case here, and, thus, there is no *prima facie* obviousness. Tellingly, when the applied prior art is dissected in a manner in which the Examiner has done, even the individual components cannot be reasonably said to meet those individual requirements of Applicants' claims.

Yamagishi '563 presents an irreconcilable conflict to Yamagishi '413 insofar as the construction of the golf ball is concerned. The Yamagishi '563 reference does not satisfy the elements of the invention in so far as distortion of the solid core of a range of 2.6 to 6.5 mm under

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a load of 100 kg. Moreover, Yamagishi '563 does not disclose a particular proportion of V_R to a particular product of the Shore D hardness.

The Examiner's conclusion that it would be obvious to include the golf ball of Yamagishi '413 to have a product of Shore D hardness of the cover inner and cover outer layers thus flies directly in the face of the disclosure of Yamagishi '563. The Yamagishi '563 reference is somewhat pertinent in that it at least provides dimple data, but clearly for use in a golf ball construction having a materially different type of core.

As such, it is believed that there is no *prima facie* obviousness in the combination of Yamagishi '413 and Yamagishi '563. Even if combined in any meaningful manner, the combination does not teach a technique of taking full advantage of the spin property which is dependent on the product of Shore D hardness of the cover inner layer and cover outer layer and improving the flight performance of the golf ball to divide the range of the product into sub-ranges and then form dimples which satisfy the requirements of the proportion of V_R and the value of V_0 associated with the sub-ranges. There is simply no recognition or suggestion of that fundamental concept. Thus, the Examiner has incorrectly concluded that the product of the Shore D hardness of the cover inner layer and the cover outer layer is in the range of 1,500 to 4,000.

Yamagishi '413 discloses a cover outer layer having a Shore D hardness in the range of 50 to 60. The inner cover layer has a Shore D hardness in the range of 28 to 68. Yamagishi '413 fails to disclose, however, that is the concept that the Shore D hardness of the cover inner and cover outer layers would be selected based on a particular combination that falls within Applicants' range. Rather, the Yamagishi '413 defines hardness of the two layers as independent considerations. Stated

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differently, Yamagishi '413 simply defines materials in which the hardness would fall within individual ranges. Critically, those ranges lead to values outside Applicants' claimed ranges. Thus, Yamagishi '413 does not teach or suggest that the Shore D hardness of the cover layers should be selected to fall specifically within a particular range based on a product of those Shore D hardness values.

The fallacy in the Examiner's position, however, is that even if the Shore D hardness values are multiplied together, Applicants' invention is not simply restricted to the product of the Shore D hardness values. Rather, Applicants' invention recites a clear interrelationship that for specific values of Shore D hardness, the value of V_R is constrained to a particular range. Independent claim 1 recites five distinct criteria in which the product of the Shore D hardness values for the cover inner layer and the cover outer layer is set to different ranges and for each the Shore D hardness range, a corresponding range of V_R is thus also set.

The issue of patentability, which the Examiner fails to harmonize with the combination of Yamagishi '413 and Yamagishi '563, is that for any particular product of Shore D hardness, given the values in Yamagishi '413, how, if at all, would Yamagishi '413 vary the value of V_R even if such parameter values were taught in the prior art? The answer is that it is entirely unknown and unresolved. The combination of Yamagishi '413 and Yamagishi '563 provides no reason or rationale to vary the dimple volume given differences in combined hardness. There is simply a void in the prior art with respect to that consideration. As such then it is respectfully contended that the Examiner's reliance on the combination of Yamagishi '413 and Yamagishi '563 is deficient and that no *prima facie* obviousness exists.

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In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

Please charge any fees necessary to maintain the pendency of this application, except for the Issue Fee, to our Deposit Account No. 19-4880.

Respectfully submitted,



Paul J. Wilson
Paul J. Wilson
Registration No. 45,879

SUGHRUE MION, PLLC
2100 Pennsylvania Avenue, N.W.
Washington, D.C. 20037-3213
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

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